

for *inter partes* reexamination of the patent for resolution of the question of whether the requester will prevail.

(b) If the order for *inter partes* reexamination resulted from a petition pursuant to § 1.927, the *inter partes* reexamination will ordinarily be conducted by an examiner other than the examiner responsible for the initial determination under § 1.923.

[65 FR 76777, Dec. 7, 2000, as amended at 76 FR 59058, Sept. 23, 2011]

#### INFORMATION DISCLOSURE IN *Inter Partes* REEXAMINATION

##### **§ 1.933 Patent owner duty of disclosure in *inter partes* reexamination proceedings.**

(a) Each individual associated with the patent owner in an *inter partes* reexamination proceeding has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability in a reexamination proceeding as set forth in § 1.555(a) and (b). The duty to disclose all information known to be material to patentability in an *inter partes* reexamination proceeding is deemed to be satisfied by filing a paper in compliance with the requirements set forth in § 1.555(a) and (b).

(b) The responsibility for compliance with this section rests upon the individuals designated in paragraph (a) of this section, and no evaluation will be made by the Office in the reexamination proceeding as to compliance with this section. If questions of compliance with this section are raised by the patent owner or the third party requester during a reexamination proceeding, they will be noted as unresolved questions in accordance with § 1.906(c).

#### OFFICE ACTIONS AND RESPONSES (BEFORE THE EXAMINER) IN *Inter Partes* REEXAMINATION

##### **§ 1.935 Initial Office action usually accompanies order for *inter partes* reexamination.**

The order for *inter partes* reexamination will usually be accompanied by the initial Office action on the merits of the reexamination.

##### **§ 1.937 Conduct of *inter partes* reexamination.**

(a) All *inter partes* reexamination proceedings, including any appeals to the Patent Trial and Appeal Board, will be conducted with special dispatch within the Office, unless the Director makes a determination that there is good cause for suspending the reexamination proceeding.

(b) The *inter partes* reexamination proceeding will be conducted in accordance with §§ 1.104 through 1.116, the sections governing the application examination process, and will result in the issuance of an *inter partes* reexamination certificate under § 1.997, except as otherwise provided.

(c) All communications between the Office and the parties to the *inter partes* reexamination which are directed to the merits of the proceeding must be in writing and filed with the Office for entry into the record of the proceeding.

(d) A petition in an *inter partes* reexamination proceeding must be accompanied by the fee set forth in § 1.20(c)(6), except for petitions under § 1.956 to extend the period for response by a patent owner, petitions under § 1.958 to accept a delayed response by a patent owner, petitions under § 1.78 to accept an unintentionally delayed benefit claim, and petitions under § 1.530(l) for correction of inventorship in a reexamination proceeding.

[65 FR 76777, as amended at 77 FR 46628, Aug. 6, 2012; 77 FR 48853, Aug. 14, 2012]

##### **§ 1.939 Unauthorized papers in *inter partes* reexamination.**

(a) If an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned.

(b) Unless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination.

##### **§ 1.941 Amendments by patent owner in *inter partes* reexamination.**

Amendments by patent owner in *inter partes* reexamination proceedings are made by filing a paper in compliance with §§ 1.530(d)–(k) and 1.943.